

Toth et al.

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REMARKS

Claims 1, 2, 5, 6, 8-14 and 16-23 are pending in the present application. In the Final Office Action mailed December 8, 2005, the Examiner rejected claims 1, 2, and 8-10 under 35 U.S.C. §103(a) as being unpatentable over Moore (USP 4,181,858). The Examiner next rejected claim 5 under 35 U.S.C. §103(a) as being unpatentable over Moore as applied to claim 1 above, and further in view of Popescu (USP 6,501,828). Claim 6 is rejected under 35 U.S.C. §103(a) as being unpatentable over Moore and Popescu as applied to claim 5 above, and further in view of Hsieh (USP 5,970,112). Claims 11, 14 and 16 are rejected under 35 U.S.C. §103(a) as being unpatentable over Moore in view of Hoffman et al. (USP 6,137,857). Claims 12 and 13 are rejected under 35 U.S.C. §103(a) as being unpatentable over Moore and Hoffman et al. as applied to claim 11 above, and further in view of Hsieh. Claims 17 and 19-21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Popescu in view of Toth et al (USP 6,307,918) and Moore. Claim 18 is rejected under 35 U.S.C. §103(a) as being unpatentable over Popescu, Toth et al, and Moore as applied to claim 17 above, and further in view of Gunji et al (JP 08-266523). Claims 22 and 23 are rejected under 35 U.S.C. §103(a) as being unpatentable over Popescu, Toth et al. and Moore as applied to claim 17 above, and further in view of Winter (USP 4,998,268).

In the Advisory Action mailed December 28, 2005, the Examiner stated the remarks and evidence provided on December 14, 2005 did not place the application in condition for allowance because "Applicant did not show good and sufficient reasons why the evidence was not earlier presented, prior to final rejection." Advisory Action, December 28, 2005, p. 3. However, when the 37 C.F.R. §1.132 declaration was filed on December 14, 2005, Applicant was unaware that the Examiner had mailed a final office action.

That is, on November 30, 2005, Applicant filed a Request for Continued Examination together with an Information Disclosure Statement. Shortly thereafter, on December 7, 2005, the undersigned called and left a voicemail message with the Examiner informing the Examiner that the additional evidentiary support requested in the advisory action of November 25, 2005 would be forthcoming. That evidence was then filed with the Office on December 14, 2005. However, in the interim between receipt of the Request for Continued Examination and December 14, 2005, the Examiner prepared and mailed a final office action. To be specific, the final office action was mailed on December 8, 2005 and was not received by the undersigned prior to preparing and filing the response filed on December 14, 2005. As such, Applicant was unaware of the need to provide the "good and sufficient reasons why the evidence was not earlier presented".

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After discussing the unusualness of this timeline with Examiner Glick, Supervisory Patent Examiner responsible for overseeing action in the matter, it was suggested that Applicant request reconsideration and provide the reasons why the evidence was not presented prior to the mailing of the final office action. Accordingly, Applicant hereby requests reconsideration.

Applicant believed the filing of the evidence on December 14, 2005, being two weeks after the filing of the Request for Continued Examination, was being filed before any action had been taken by the Examiner. As the final office action was not received until after the evidence was presented to the Office, Applicant could not possibly have known of or expected such a quick issuance of an office action by the Examiner. Moreover, the undersigned had left a message with the Examiner, on December 7, 2005, notifying the Examiner that the requested evidentiary support was forthcoming. As such, the Examiner, at a minimum, was alerted that further action by the Applicant in the case was forthcoming. In fact, the message was left with the Examiner prior to the mailing of the final office action.

Applicant appreciates that it would be improper to ask the Examiner to discard several hours of work in preparing a response based on an indication from an applicant that an applicant intended to file more remarks with the Office. In the present case, however, the rejections of the final office action mailed on December 8, 2005 were near-verbatim of those of the final office action mailed on October 12, 2005. As such, the Examiner had not expended great time and energy in formulating the final rejections of December 8, 2005.

In sum, the evidence presented on December 14, 2005 was not presented prior to the issuance of a final office action the time because to prepare the 1.132 declaration and gather the documentary support took a couple of weeks to put together. That is, in the Advisory Action mailed on November 25, 2005, Applicant requested evidentiary support for the arguments presented on November 16, 2005. That Advisory Action was not received by the undersigned until November 28, 2005. Internal office processing and docketing of the Advisory Action took a few days. The undersigned then began to review the Advisory Action on December 7, 2005, the same that the undersigned phoned the Examiner and left a voicemail message that a response was forthcoming. Only one week later, a 1.132 declaration together with supporting documentation was filed with the Office. As such, there was no delay in receiving, docketing, and responding to the Examiner's outstanding requirements. The ordinary time to review the Advisory Action and respond accordingly, coupled with the unusually quick turnaround time by the Office regarding the Request for Continued Examination, resulted in the December 14, 2005 filing being after the mailing of the final office action of December 8, 2005.

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Therefore, it is believed that good and sufficient reasons have been presented as to why the 1.132 declaration filed on December 14, 2005 was not filed prior to the mailing of the final office action on December 8, 2005.

Regarding the outstanding rejections, Applicant believes the Declaration of Thomas L. Thoth establishes that the particulars of claimed invention are not merely a matter of design choice. The claimed invention and, in particular, the claimed orientation of the x-ray attenuating filters, results in advantages that were not expected nor suggested by the art of record. Specifically, as set forth previously, it was found that the acceptance angle of a detector cell saw more filter surface area if the curved portions of the filters faced the detector which resulted in the detector receiving a greater amount of un-attenuated scatter from the surface of the filter. In short, the claimed orientation is more advantageous than the filter orientation disclosed and/or suggested by the art of record.

As set forth in the Declaration, the claimed orientation is not simply a matter of design choice. The Examiner's conclusion is predicated upon the belief that one skilled in the art would have been motivated to modify the teachings of the references to reach the claimed invention simply as a matter of space-savings design. In this regard, it follows that one skilled in the art would have expected the same results with the claimed invention as those expected with the filters disclosed by the art of record. That is not the case. Applicant found that the claimed orientation provided advantages beyond those taught and/or suggested by the art of record. Evidence thereof was set forth in the Declaration.

Regarding the rejection of claim 17, Applicant disagrees that the combination of Popescu, Toth et al., and Moore suggests the claimed invention. As set forth previously, Moore teaches away from the combination. The Examiner has asserted that Moore has only been relied upon for its teaching of "motors for filters"; however, it is well-established that "a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." MPEP §2141.02, VI citing W.L. Gore & Associates, Inc. v. Garlock, Inc. 721, F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983). As such, the Examiner must consider Moore in its entirety, not simply for its teaching of filter motors. In this regard, if Moore, as a whole, teaches away from a combination with a reference, one skilled in the art would not be motivated to form the combination notwithstanding that a particular portion of the disclosure may be combinable. Therefore, as Moore teaches that, at a minimum, its filter wedges overlap one another, a skilled artisan would conclude that it would be unnecessary to have a stationary filter,

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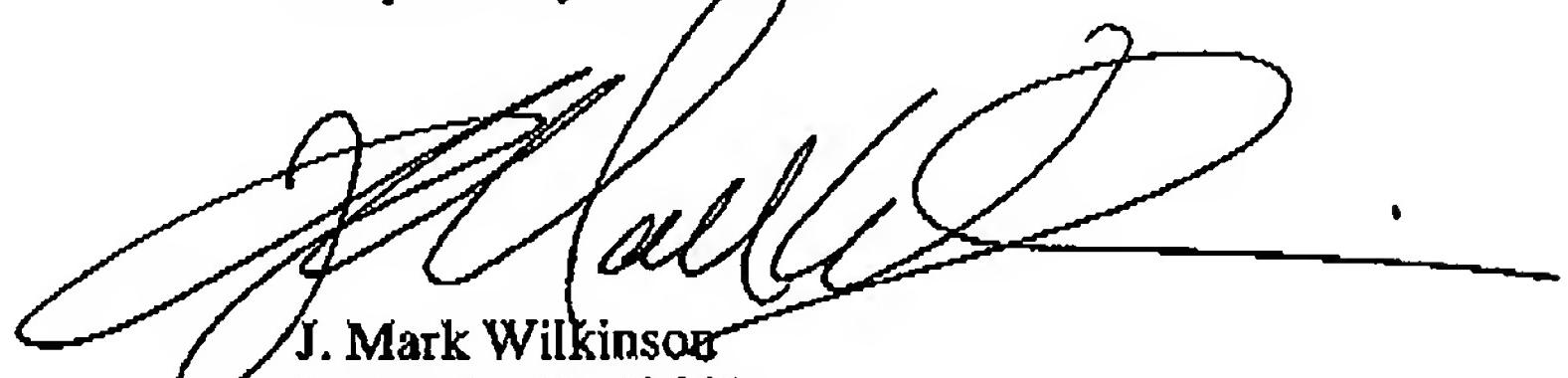
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as called for in claim 17. Accordingly, it is believed that the art of record, *when considered in its entirety*, fails to teach or suggest the invention called for in claim 17.

Therefore, in light of at least the foregoing and the enclosure, Applicant believes that the pending claims define the claimed invention over the art of record and, as such, requests a allowance of claims 1, 2, 5, 6, 8-14, and 16-23.

Applicant appreciates the Examiner's consideration of these Amendments and Remarks and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved.

Respectfully submitted,



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